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In re Application of:
MIZUNO, Hitoshi, et al. :
U.S. Application No.: 10/565,154 :
PCT No.: PCT/JP2005/002718 :
International Filing Date: 21 February 2005 :
Priority Date: 20 February 2004 :
Atty's Docket No.: OMY-0050 :
For: CONTAINER, STORING BATH AND :
A METHOD OF PRODUCING THE :
CONTAINER :

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47 To Accept Declaration When Inventor Refuses To Join In Application" filed 28 August 2008. Applicants have paid the required petition fee.

BACKGROUND

On 21 February 2005, applicants filed international application PCT/JP2005/002718. The international application claimed a priority date of 20 February 2004, and it designated the United States. On 01 September 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 August 2006.

On 19 January 2006, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee, a translation of the international application into English, and a declaration executed by one of the two inventors of record.

On 27 February 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Acceptance (Form PCT/DO/EO/903) identifying 19 January 2006 as the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) Requirements" and 20 August 2006 as the "Date Of Completion Of All U.S.C. 371 Requirements." On the same date, a filing receipt was mailed identifying the 35 U.S.C. 371(c) date as 19 January 2006.

On 03 June 2008, an Office Action was mailed rejecting the claims herein. The Office Action objected to the declaration in that it was not signed by both of the inventors of record.

On 28 August 2008, applicants filed the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Tsuyoshi ABE, whom applicants assert has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants' 19 January 2006 submission to initiate the present application included a declaration executed by one of the two inventors of record. The declaration contains an unsigned signature block for the non-signing inventor, Tsuyoshi ABE. This declaration can be accepted as having been executed by the signing inventor on his own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a firsthand statement, accompanied by supporting documents, demonstrating that a request for signature, accompanied by a copy of the complete application, was delivered to the non-signing inventor at his last known address on two different occasions, and that the inventor has failed to provide the requested signature in response to these

requests. These materials provide an acceptable showing that the non-signing inventor has refused to execute the declaration. Item (4) is therefore satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing inventor Tsuyoshi ABE.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the inventor's last-known address, as set forth in the petition.

Because the present decision does not effect the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4), a revised "Notification Of Acceptance" (Form PCT/DO/EO/903) and filing receipt are not required.

The application is being referred to the Group Art Unit for further processing.



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For: CONTAINER, STORING BATH AND A METHOD OF PRODUCING THE
CONTAINER

Dear Mr. ABE:

You are identified as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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